

### **III. REMARKS**

#### **Status of the Claims**

Claims 1-19 are presented for reconsideration.

#### **Summary of the Office Action**

Claims 1-3, 5-14, and 16-19, stand rejected under 35USC103(a) on the basis of the cited reference Wang, U.S. Patent No. 5,917,913 in view of the cited reference Ramaswamy, et al, U.S. Patent No. 6,832,082 and further in view of the disclosure of Thompson, U.S. Publication No. 20002/0022483. This rejection is traversed on the following grounds:

The combined teaching of Wang, Ramaswamy, and Thompson does not render claims 1-3, 5-14, and 16-19 obvious because it fails to teach or otherwise suggest each and every limitation of the claims. It is well settled that in order to establish a prima facie case for obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, without reference to the disclosure of this application. (MPEP Section 2142) ***In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria."**

In particular the combined teaching fails to disclose or suggest the claimed features of independent claims 1, 16, and 17 as stated below:

In claims 1 and 16

**"identification means, separate from said communication means, said identification means arranged to independently provide information identifying said portable communications device, from said identification means to said second device,"**

The Examiner acknowledges that the reference Wang fails to disclose or suggest this feature and seeks to combine the disclosure of Wang with that of Ramaswamy to partially support the rejection based on obviousness.

further in claims 1 and 16,

**"to establish a communication connection between said communication means and said second device"**

The Examiner acknowledges that the combined teaching of Wang and Ramaswamy fails to disclose or suggest the above feature. Thereupon the Examiner seeks to further combine the disclosures of Wang and Ramaswamy with the disclosure of Thompson.

Claim 17 describes a method having limitations equivalent to those of claims 1 and 16 described above and the Examiner rejects claim 17 utilizing a similar sequence of supporting assertions.

Yet a careful review of the cited references reveals that, neither the combined teaching nor the cited references taken alone disclose or suggest these features. Therefore, the cited references taken alone or in combination fail to support the rejection based on obviousness.

The claimed subject matter relates to means for establishing a communication connection between a portable communication device and a second device, for example, a point of service device. There are two independent communications set up, one that is used for transmitting transaction information and another that is used for transmitting identification information relating to the particular portable communication device. The identification means is a separate link and may be as simple as a bar code readable by the point of sale device. The identification means enables a separate communication connection for transmitting, for example, a transaction. The cited references either alone or in combination fail to show such a system.

The reference Thompson discloses a system by which a portable computing device may identify the wireless service provider to which the portable computing device subscribes. This is accomplished by communication with an access point of a wide area network, such as the Internet. There is no identification of the portable computing device in this communication and there is only the one communication link. The disclosure of the reference Thompson does not remedy the acknowledged deficiencies of the disclosures of Wang and Ramaswamy.

It does not appear that the Examiner has considered the claims as a whole but has dismantled the claims and pursued a search for the individual features in order to create a mosaic that he asserts resembles the claimed subject matter of this application. It is well settled that "the actual determination of the issue requires an evaluation in the light of the findings in those inquiries of the obviousness of the claimed invention as whole, not merely the differences between the claimed invention and the prior art." (*Graham v. John Deere Co.*, 383U.S.17). The court admonishes in *In re Fritch*, 972F.2d1260 as follow:

**"It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."**

Applicant's position above is supported by the fact that the Examiner has not adequately explained the proposed modification of the references Wang, Ramaswamy, and Thompson required to arrive at the claimed invention nor is there any explanation why such proposed modification would have been obvious to a person skilled in the art at the time of the invention. Applicant submits that there is no motivation for such a combination.

Wang discloses a system for approving a transaction request between an electronic transaction system 202 (e.g. an ATM) and a portable electronic authorization device 200 (PEAD). For example, see Figure 2 of Wang.

Ramaswamy discloses a wireless system comprising a wireless handset 120 and a base unit 111 (column 1, lines 53-54 and Figure 1). Amongst a number of other features, according to Ramaswamy the base unit 111 and handset 120 can communicate by both a wired interface and a radio frequency (RF channel).

Thompson discloses a system for providing Internet connections for portable computers in a wireless public-access network, and for enabling roaming amongst different wireless Internet service providers (e.g. see paragraph 27).

In order to arrive at the present invention based only on the cited references and without hindsight, the person of ordinary skill would have had to go through each of the following stages of reasoning and experimentation:

1. Identify some deficiency in Wang or some other motivation that would lead the person of ordinary skill to seek to modify Wang, despite there being no suggestion of any such deficiency or motivation in Wang. The Examiner has not explained where there is anything that would encourage the addition of a separate link for imparting identification information in the system of Wang.
2. Isolate the feature of providing an identification by a separate wired link from Ramaswamy as being relevant to the goal identified in step 1, despite there being no such suggestion in Ramaswamy and further ignoring that the system of Ramaswamy bears no similarity to the system of Wang.

3. Recognize that a feature from a household telephone system is in some way suitable for use in a system for conducting transactions via an ATM while ignoring the fact that the system doesn't need such a feature.
4. Isolate the feature of enabling Internet connections from Thompson as being relevant to the imagined need of the system of Wang identified in step 1, despite there being no such suggestion in Thompson and ignoring the fact that the system of Thompson bears no similarity to the systems of Wang or Ramaswamy.
5. Recognize that the imagined feature of Thompson used for enabling Internet connections is suitable for assisting transactions via an ATM.
6. Recognize that the features isolated above would be compatible with one another.
7. Arrange those features in the specific manner claimed so as to achieve that goal.

Applicant submits that the above chain would require invention and not merely and obvious compilation of prior art disclosures.

The Applicants submit that the disclosures of the cite references Wang, Ramaswamy, and Thompson are improperly combined. References may be combined under 35 U.S.C. §103(a) only if the references are analogous art. In this case, the references Ramaswamy and Thompson are not analogous art to Wang or each other. A reference is analogous art if:

- 1) The reference is in the same field of endeavor as the subject matter of applicants claimed subject matter, or
- 2) The reference is reasonably pertinent to the particular problem with which the applicant was concerned.

Although the three citations do relate generally to wireless systems, they have three otherwise very diverse applications, i.e. ATM transactions, household phones and Internet access. Applicant is at a loss to understand how a disclosure (Wang) relating to ATM transactions can be considered to be an analogous art to disclosures relating to domestic cordless telephones (Ramaswamy) or public network Internet access (Thompson). A person of ordinary skill would not seek to combine the features from such diverse systems. By the same logic, it could be argued for example that it would be obvious to combine features from a television and a vacuum cleaner simply because they were both in the art of "household appliances".

The individual references that are combined by the Examiner to generate the teaching upon which the Examiner relies are not pertinent to the solution of the problem stated in this application, namely, to assure that in a point of sale environment a mobile communication device through which a transaction is sought to be consummated is properly identified and distinguished from other mobile communication devices in the immediate area. What possible application could the cited disclosures have with respect to the solution to this problem? The individual references are not pertinent and therefore they are not analogous.

The combination of the teachings of Wang, Ramaswamy and Thompson is further traversed because there is no motivation in such diverse disclosures to obtain Applicant's invention. In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. There must also be a reasonable expectation of success, and the reference(s), when combined, must teach or suggest all of the claim limitations. (See M.P.E.P. §2142). As noted above, the combined teaching fails to disclose or suggest each feature of Applicants' invention as claimed.

Neither reference provides the requisite suggestion or motivation to modify the references as proposed by the Examiner. The Examiner's proposition that Applicants' invention would be obvious as recited in the claims is not supported by the combined teaching of Wang, Ramaswamy and Thompson.

The references themselves and/or the knowledge generally available to one of skill in the art do not provide the requisite motivation or suggestion to modify the references as proposed for purposes of 35 U.S.C. §103(a). When "the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference". In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). The Examiner is requested to provide an indication as to where any such teaching, suggestion or motivation appears in the references. Absent such a teaching, it is submitted that the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a) with respect to the subject of independent claims 14,15, and 19. Clearly a person skilled in the art of ATM style electronic transactions would not look to Ramaswamy or Thompson as a source for modifying the teaching of Wang.

These grounds apply equally to the rejected dependent claims, all of which, by dependency, have the limitations described in the independent claims. The cited reference Thompson fails to remedy the deficiencies of the primary combined teaching of Wang and Ramaswamy.

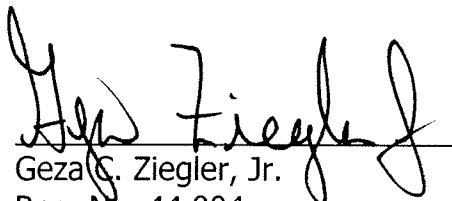
The Examiner has further rejected dependent claims 2-4, and 15 under 35USC103(a) on the basis of the cited reference Wang, U.S. Patent No. 5,917,913 in view of the cited reference Ramaswamy, and further in view of the cited reference McGregor, et al, U.S. Patent No. 5,625,669. The Examiner is respectfully requested to reconsider his rejection in view of the above and the following remarks. This rejection is traversed on all of the grounds expressed in the remarks above.

The reference Applicant submits the combined teaching of Wang, Ramaswamy, and McGregor that fails to disclose or suggest all of the limitations of the claims as indicated above. The deficiencies of the primary reference Wang are not remedied by the proposed combination with the teaching of the references Ramaswamy and or McGregor, et al. The combined references do not therefore support a prima-facie case of obviousness. The modification of the teachings of Wang, Ramaswamy or McGregor, in order to obtain the invention, as described in the claims submitted herein, would not have been obvious to one skilled in the art.

For all of the above reasons, it is respectfully submitted that all of the claims now present in the application are novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for the three month extension of time fee (\$1020) as well any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

  
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23 MARCH 2007  
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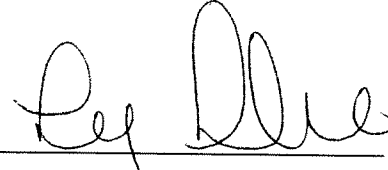


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